

Our Reference: TMA-105-A

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: John J. Borzym
Serial Number: 10/762,430
Filing Date: January 22, 2004
Examiner/Art Group Unit: Maurina T. Rachuba/3723
Title: SUPPORTED SHEAR WITH REVERSIBLE
DRIVE AND METHOD OF OPERATING SAME

APPELLANT'S REPLY BRIEF

MAIL STOP APPEAL BRIEF-PATENTS
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is Appellant's Brief in Reply to the Examiner's Answer filed October 11, 2007.

OBVIOUSNESS UNDER THE RULE OF KSR.

In response to Appellant's brief the Examiner argues broadly that the rejection of the appealed claims under 35 U.S.C § 103 on the combination of Carmichael et al and Ward is in keeping with the law as set forth in *KSR International co. v. Teleflex Inc.* 82 USPQ2d 1385 (US Supreme Court 2007). In what specific way or with what specific language *KSR* is believed to support the rejection is not explained. It is important to recognize that while the *KSR* court cautioned against a "rigid" application of the "teaching, suggestion or motivation" (TSM) test, the Court acknowledged the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the references in the way the claimed new invention does".

In *KSR*, the reason or rationale was market pressure combined with the fact that the prior art in the combination comes from the same commercial application;

i.e. pedal position detection and responses thereto. The invention in *KSR* was deemed “ready for improvement” in that its drawbacks had been identified by participants in the market prior to the invention and the mechanism for bringing about the improvement was readily available in the same field. In short, the *KSR* product was “ready for improvement” and the means to do so was readily available.

No such argument can be made here; in fact the facts are quite to the contrary. Carmichael et al teaches at least part of the mechanisms for producing both linear and rotary movement of a die holder which holds a tube. As explained in column 3 ll. 61-68, “Linear movement of the slide 8 is brought about by a pneumatic or hydraulic ram (not shown) and the slide is movable between two end positions determined by limit stops (not shown), in one of which positions the two dies 1 and 4 are aligned and in the other of which the moveable die 4 is eccentric in by the desired amount”.

The rotary motion is brought about by the mechanism illustrated in Figure 2 and described in column 3 ll. 57-62; “the rotatable guide holder projects from the slide block 8 and that part of its outer peripheral face which projects beyond the block 8 is toothed for co-operation with a chain 12 connected to a suitable drive means (not shown)”. In short, it is a chain and sprocket drive.

Carmichael et al does not begin to suggest that his device needs or is ready for improvement beyond suggesting in column 4 ll. 24-32 that with “additional complexity” the die may be caused to move in opposite direction if the shearing movement is to be completed in only 180 degrees of rotation.

This half-hearted (if not “negative”) suggestion falls far short of suggesting that the rotary drive means is ready for improvement other than to shorten the stroke and make it reversible. Indeed Carmichael et al never says what his “drive means” should be; note the parenthetical expression (not shown) in column 3 ll. 60-61. A reversible motor would be compatible with a chain and sprocket drive. This is not an invitation to use a rack and pinion drive with or without the variable power feature (of claim 5). Accordingly, the rationale of *KSR* does not appear to apply in this case. It can not be argued that *KSR* opens up a broad range of obviousness rejection based on the Examiner’s personal opinion that elements of diverse prior art references can be combined. In the absence of evidence of market pressure or some other “reason” for

combining the elements of the references, the Examiner's theory of obviousness stands unproven.

WARD IS NON-ANALOGOUS ART

The Examiner aggravates the error by suggesting that it would be obvious to select the drive system of Ward for use in Carmichael et al because both references fall into the category of "machine tools". The Examiner is simply ducking the fact that the law requires that the references being combined be in the field of the Applicant's endeavor or reasonably related to the particular problem for which the inventor was concerned. The Ward reference does not satisfy that rule and there is no alternative rationale for reaching in to the grinding machine art for ways to modify tube cutters.

WARD DOES NOT TEACH A MECHANISM FOR VARYING THE POWER LEVEL OF THE DRIVE DURING THE DRIVE STROKE AS REQUIRED BY CLAIM 5 ON APPEAL

The Examiner recognizes that claim 5 calls for the provision of "means" for varying the power level of the stroke during the stroke but argues that this is inherent in Ward. The Examiner does not expressly recognize that the "means for . . ." language of claim 5 invokes § 112 ¶ 6. The Examiner argues on page 4 of the Examiner's Answer that varying the power level of the hydraulic power means during translation of the rack is a natural consequence of switching the direction of movement as described in column 3 ll 2-9 of Ward; i.e. the mechanism must slow down before it can begin moving in the opposite direction.

The Examiner's approach looks only at function. But the claim specifically calls for "means" for achieving a variation in power level during the stroke in a programmed fashion; it is not sufficient to look only at the recited function and ignore differences in structure. Furthermore, the functional comparison is itself weak; the argument that an abrupt switch in direction somehow inherently produces the equivalent of a programmed speed change is not persuasive. Throwing an automobile into reverse during forward movement can hardly be described as "means" for varying the power level of the engine. This argument should be rejected on its face and claim 5 summarily allowed.

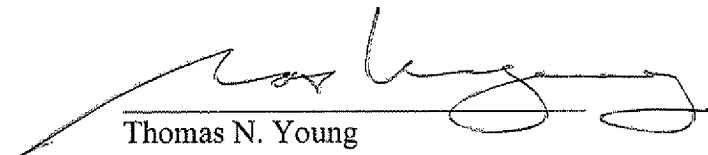
A similar argument can be made with respect to claim 6; i.e. there is

nothing in either of the references to specifically relates to the extent of rack movement to pinion rotation. The Examiner is simply substituting personal opinion for actual teaching in the prior art.

CONCLUSION

For the reasons set forth above the rejections of all claims on appeal should be reversed and the application returned to the Examining Group with instruction to issue a Notice of Allowance forthwith.

Respectfully submitted,



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